

10/713,637  
END5240USNP

Remarks

Status of Claims:

Claims 1-31 were rejected. None of the claims are being amended herein.

§ 102 Rejections:

Claims 12-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Kovacs et al. (U.S. 5,833,603). Applicant respectfully traverses these rejections.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicant submits that Kovacs et al. fails to anticipate independent claim 12.

Independent claim 12 recites an act of marking target cells in a patient with a substance capable of being detected, and an act of determining whether a particular tissue is present in a patient using transformed data indicative of the presence of the substance in the patient. Kovacs et al. fails to teach or suggest such limitations, among others, particularly in the arrangement required by independent claim 12. Despite this same deficiency having been pointed out by Applicant in the response filed 05/22/06, the Office has failed to cite any portion of Kovacs et al. that teaches an act of "marking target cells in a patient" as recited in claim 12. The Office has instead purported to reject claim 12 by discussing limitations that are not even recited in claim 12. Accordingly, Applicant respectfully submits that Kovacs et al. fails to anticipate independent claim 12 in accordance with MPEP 2131, and respectfully requests that the rejections be withdrawn.

Furthermore, independent claim 12 recites "wherein the act of determining whether a particular tissue is present in the patient is performed using at least part of the transformed data." As recited in claim 12, the "transformed data" is a result of the act of "transforming" recited in claim 12, and represents a transformation of signals detected by the detector. As is further recited in claim 12, the signals are from the substance used in the act of "marking" recited in claim 12. These limitations, and their particular arrangement required by claim 12, are not taught or suggested by Kovacs et al. In purporting to reject claim 12, the Office has

10/713,637  
ENDS240USNP

cited a passage of Kovacs et al. that discusses "sensing physical parameter values related to other implants in a patient, including temporary implants, living tissue implants, and medical prostheses, in addition to sensing physical parameter values directly related to the patient's organs and tissue." (Col. 3, ll. 28-32). Contrary to the Office's suggestion, this does not constitute a teaching of "determining whether a particular tissue is present" as recited in claim 12. Even if it did constitute such a teaching, it does not teach such an act using transformation of signals from a substance administered during an act of marking as recited in claim 12. Indeed, Kovacs et al. is silent on any method acts performed to accomplish its "sensing physical parameter values." In view of the foregoing, Applicant respectfully submits that Kovacs et al. fails to anticipate independent claim 12 in accordance with MPEP 2131, and respectfully requests that the rejections be withdrawn.

#### §103 Rejections

Claims 1-11 and 28-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kovacs et al. in view of Iddan et al. (U.S. Pat. No. 5,604,531) and Okada et al. (U.S. Pat. No. 5,424,546). Applicant respectfully traverses these rejections.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each independent claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a

10/713,637  
END5240USNP

*prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

For instance, Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in independent claim 1. In particular, the combined art of record fails to teach or suggest, among other things, a detector, a pulse shaping device, and at least one single channel analyzer, each provided within a capsule. Neither Kovacs et al. nor any of the other references teach such limitations. Accordingly, the combined art of record fails to render independent claim 1 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

With respect to independent claim 11, Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in independent claim 11. In particular, the combined art of record fails to teach or suggest, among other things, a detector operable to detect "a particular tissue" by detecting "a substance associated with the particular tissue." The Office has purported to reject claim 11 by alleging that Kovacs et al. teaches "a substance for associating with a target tissue where the substance is capable of being detected by the detector," citing Col. 3, line 10 through Col. 4, line 59 and Col. 6, ll. 8-56. Applicant notes that an actual reading of the passage cited by the Office mentions nothing of "target tissue," or more accurately, a detection of "a particular tissue" by detecting "a substance associated with the particular tissue" as recited in claim 11. Furthermore, such limitations are not taught or suggested in any other portion of Kovacs et al. or in the remaining art of record. The combined art of record therefore fails to render independent claim 11 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

Applicant further submits that the combined art of record fails to teach or suggest all of the limitations recited in independent claim 28. For instance, claim 28 recites an act of "providing a substance having an affinity for a particular target tissue type" and an act of administering the substance to the patient, along with an act of analyzing a data signal to determine whether the particular target tissue type is present in the patient. Neither Kovacs et al. nor any of the other references teach such limitations. Accordingly, the combined art of record fails to render independent claim 28 obvious in accordance with MPEP 2143.03.

- 4 -

Doc 31898v1

10/713,637  
END5240USNP

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is also well settled that an "obvious to try" rationale is insufficient to satisfy the Office's burden under MPEP 2143.01.

In formulating the pending §103 rejections, the Office has failed to articulate any motivation whatsoever to combine or modify the teachings of the references in order to obtain the invention presently claimed. Instead, the Office has merely cobbled together random teachings of the prior art in order to allegedly find the subject matter of limitations recited in the present claims. Upon completion of such cobbling, the Office simply concludes "Therefore, it would have been obvious," without any further explanation. At most, this amounts to nothing more than an "obvious to try" rationale, which is clearly unacceptable under MPEP 2145. Again, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In addition to failing to articulate any rationale to establish the motivation required by MPEP 2143.01, the Office has failed to provide any evidence to support such a rationale. In short, without any rationale on motivation to combine/modify, and without any actual evidence to support the same, the Office has fallen far short of its burden under MPEP 2143.01. Because the motivation element of a *prima facie* obviousness case required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Beyond the foregoing shortcomings with respect to the rejections of the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

Applicant further objects to the Office's use of "omnibus rejections," which impermissibly group claims together and fail to address each and every limitation recited in those claims. By way of example only, the Office has not addressed the limitations added by

10/713,637  
END5240USNP

claims 29-31, such that the Applicant has not been given a full and fair opportunity to address the rejections of the same. Omnibus rejections such as those used in the present Office Action are improper under MPEP 707.07(d), and the Office is respectfully requested to treat each and every limitation of each and every claim on its own merits in the next Office Action.

While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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- 6 -

Doc 31898v1